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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/031,996

02/08/2002

Joseph Borkowski

2644/1F609-US4

1064

7590  
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Brooklyn, NY 11201

04/02/2007

EXAMINER

MALHOTRA, SANJEEV

ART UNIT

PAPER NUMBER

3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/031,996

**Applicant(s)**

BORKOWSKI, JOSEPH

**Examiner**

Sanjeev Malhotra

**Art Unit**

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of: . . . . .
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

This is the first Office Action in response to the application filed on February 8, 2002 and titled: "System and Method for Managing Swap Orders".

### ***Claim Restrictions***

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 USC 121:

**Invention (Group) I:** Claims 1-14 are directed to in a computer implemented system, a method for identifying a current swap market in one or more tradable instruments.

**Invention (Group) II:** Claims 15-21 are directed to in an automated system, a method for identifying on a display of a computer a current swap market consisting of a best bid order and a best offer order among plural pending orders to trade a particular instrument, each pending order including a price for the instrument priced relative to a versus for an underlying security and a specified move percentage.

**Invention (Group) III:** Claims 22-37 are directed to a method for swapping a financially tradeable instrument comprising the steps of: providing a plurality of swap orders for display at a station connected to a distributed computer network, each swap order specifying a price for the instrument, a number of the instrument to be traded, and a hedge; obtaining at a central server a selection of a particular swap order from the station; obtaining at the central server terms from the station for executing the trade; comparing the terms for executing the trade to the price, number and hedge specified in the particular swap order; and handling the swap order by automatically executing the swap order in the event that the terms match.

**Invention (Group) IV:** Claims 38-42 are directed to a method for swapping a financially tradeable instrument comprising the steps of: displaying at a station connected to a distributed computer network a plurality of swap orders, each swap order specifying a price for the instrument, a number of the instrument to be traded, and a hedge; selecting a particular swap order at the station; confirming that the terms of the selected swap order are acceptable; and forwarding the swap order for automatic execution.

The inventions in four groups named above are distinct from each other as further shown by/in their descriptions below. Inventions in Groups I, II, III and IV for method groups are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different method inventions are disclosed in Groups I, II, III and IV. The inventions are distinct, each from the other because of the following reasons:

**Inventions of Group I** (claims 1-14) are drawn to a method for: receiving plural bids and offers for at least one tradeable instrument, each bid and offer including move percent data which relates new values for the bids and the offers to changes in price in an underlying instrument; periodically updating the bids and offers using the move percent data in response to changes in price in the underlying instrument; providing an electronic display of at least a best bid, having the highest price bid for the at least one tradeable instrument, and a best offer, having the lowest price offered to sell the at least one tradeable instrument, wherein the best bid and best offer are correlated with a particular price of a predetermined underlying instrument. Group I is unrelated to Groups II, III and IV, because Group I requires periodically updating the bids and offers using the

move percent data in response to changes in the underlying instrument, while the other three method groups II, III and IV do NOT require such updating as shown below in their descriptions.

**Inventions of Group II** (claims 15-21) are drawn to a method for: providing a current price quote on the underlying security to the computer; calculating a difference value between the versus and the current price quote for each of the pending orders; automatically modifying each of the pending orders to effect dollar neutraling; and displaying at least a portion of the modified orders. Group II is unrelated to Groups I, III and IV, because Group II is a method for calculating a difference value between the versus and the current price quote for each of the pending orders and automatically modifying each of the pending orders to effect dollar neutraling, while Groups I, III and IV do not require such calculating and automatic updating.

**Inventions of Group III** (claims 22-37) are drawn to a method for: providing a plurality of swap orders for display at a station connected to a distributed computer network, each swap order specifying a price for the instrument, a number of the instrument to be traded, and a hedge; obtaining at a central server a selection of a particular swap order from the station; obtaining at the central server terms from the station for executing the trade; comparing the terms for executing the trade to the price, number and hedge specified in the particular swap order; and handling the swap order by automatically executing the swap order in the event that the terms match. Group III is unrelated to Groups I, II, and IV, because Group III is a method for obtaining at the central server terms from the station for executing the trade and comparing the terms for executing the trade to the price, number and hedge specified in the particular swap order, while Groups I, II and IV do not require such obtaining of server terms and comparing the terms.

**Inventions of Group IV** (claims 38-42) are drawn to a method for: displaying at a station connected to a distributed computer network a plurality of swap orders, each swap order specifying a price for the instrument, a number of the instrument to be traded, and a

hedge; selecting a particular swap order at the station; confirming that the terms of the selected swap order are acceptable; and forwarding the swap order for automatic execution. Group IV is unrelated to Groups I, II, and III, because Group IV is a method for selecting a particular swap order at the station and confirming that the terms of the selected swap order are acceptable; while Groups I, II and IV do not require such selecting and confirming.

Based on the foregoing analysis, it is asserted that each group of invention would require separate search of its own thereby imposing undue burden on the examiner.

Because these inventions in Groups I to IV are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required, because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

No telephone interview was conducted as there is NO phone number available for the inventor in the data sheet in PALM system and the application is being prosecuted by the applicant *pro se* (see MPEP § 812.01).

The applicant is advised that a reply to this requirement must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.43). Because these Inventions (Groups) I-IV are distinct as explained above, it is asserted that each group of invention would require a separate search of its own imposing undue burden on the examiner.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17.

### ***Conclusion***

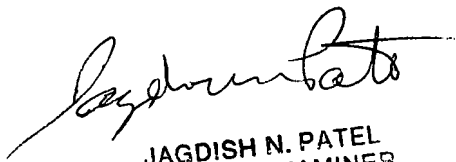
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SM



JAGDISH N. PATEL  
PRIMARY EXAMINER